

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Shiv Kumar AGARWAL et al.

Group Art Unit: 1624

Application No.: 10/827,368

Examiner: D. RAO

Filed: April 20, 2004

Docket No.: 115683.01

For: NOVEL PYRIMIDONE DERIVATIVES

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the May 10, 2006 Restriction and Election of Species Requirement, Applicants provisionally elect Group I, claims 1-3 and 14-17. Further, Applicants provisionally elect the species 5-cyano-1-(3,4-dimethylphenyl)-4-(methylthio)-2-[4-(methylthio)phenyl]-6-oxo-1,6-dihydropyrimidine (tenth compound listed in claim 3, also described as Example 10 in the specification).¹ At least elected claims 1-3 and 14-17 are generic to the elected species. These elections are made with traverse.

Regarding the elected species, Applicants understand that upon examination and allowance of the elected species, the examination will continue for additional species, and that upon allowance of a generic claim, all such species will be rejoined and allowed.

Regarding the elected Group, Applicants submit that at least claims 1-8 and 14-36 are sufficiently related that a search of all of these claims together is warranted. Specifically,

¹ This compound may also be identified as 1-(3,4-dimethylphenyl)-4-(methylthio)-2-[4-(methylthio)phenyl]-6-oxo-1,6-dihydropyrimidine-5-carbonitrile.

each of these claims are drawn to the same general compounds, either as claims directed to the compounds themselves, claims directed to methods of making the compounds, or claims directed to methods of use of the compounds.

It is thus respectfully submitted that the subject matter of at least claims 1-8 and 14-36 is sufficiently related that a thorough search for the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Moreover, as noted by the Patent Office, at least claims 4-8 and 18-36 should be rejoined with the application upon allowance of elected product claims 1-3 and 14-17. This further should mitigate against maintenance of the Restriction Requirement at this stage of prosecution.

For the foregoing reasons, withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Leana Levin
Registration No. 51,939

JAO:LL/rav

Date: June 21, 2006

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
